



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,286	03/16/2001	Jacques Fieschi	FR920000012US1	5924
7590		04/01/2004	EXAMINER	
ANDREW CALDER		WORJLOH, JALATEE		
MCGUIRE WOOD LLP				
1750 TYSONS BLVD		ART UNIT		
SUITE 1800		PAPER NUMBER		
MCLEAN, VA 22102		3621		

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,286

Applicant(s)

FIESCHI ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on January 9, 2004, wherein claims 1-8 were amended and claims 9-20 added.

Response to Arguments

2. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Art Unit: 3621

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4, 8, 9 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US Publication No. 2002/0077837 to Krueger et al.

Krueger et al. disclose registering a purchase of at least one article by a buyer using a credit/debit card associated with at least one PIN code at a seller terminal connected to an electronic payment center (i.e. “trusted third party”), checking, by the electronic payment center, that the at least one PIN code which is provided by said buyer to said electronic payment center is associated with the number of said credit/debit card provided by said buyer to said seller terminal and checking, by said electronic center, with a third party (i.e. “debit/check card

processing network”) whether said the at least one PIN code is valid (see paragraphs [0029] and [0030]).

Referring to claim 2, Krueger et al. disclose the method wherein said buyer has a terminal which is connected to a communication network and said terminal is configured to transmit the credit/debit card number to said seller terminal (see paragraph [0029], lines 1-11).

Referring to claim 3, Krueger et al. disclose the method wherein the credit/debit card number which has been provided to said seller terminal by said buyer is transmitted to said electronic payment center to check whether the PIN code provided by said buyer is associated with said credit/debit card number (see paragraph [0029], lines 11-15).

Referring to claim 4, Krueger et al. disclose the method wherein said electronic payment center checks in at least one profile table (i.e. “customer database”) whether said PIN code is associated with the credit/debit card number (see paragraph [0029], lines 9-11 and [0030]).

Referring to claim 8, Krueger et al. disclose means adapted for performing the steps of claim 1 or claim 2 (see claim 1 above).

Referring to claim 9, Krueger et al. disclose receiving transaction information from a buyer and a seller by an electronic payment center (i.e. “third party”), performing a first validation with the transaction information from the buyer and seller by the electronic payment center and requesting, by the electronic payment center, further validation from a third party (i.e. “processing network”) to provide authentication for a sale by an electronic transaction (see paragraphs [0029] and [0030]).

Referring to claims 13 and 14, Krueger et al. disclose the method wherein said electronic payment center checks in at least one profile table information (i.e. “customer database”)

whether; wherein the profile table information comprises at least one of a credit/debit card number, a buyer PIN code, and authorization amount corresponding to the buyer PIN code (see paragraph [0029], lines 9-11 and [0030]).

Referring to claim 15, Krueger et al. disclose the electronic payment center clears the one portion of transaction information from the third party (see paragraph [0030]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krueger et al. as applied to claim 4 above, and further in view of US Publication No. 2001/0039535 to Tsiounis et al.

Krueger et al. disclose checking by said electronic payment center that the at least one PIN code is associated with the card number (see claim 1 above). Krueger et al. do not expressly disclose checking by said electronic payment center whether the amount of said purchase of the at least one article is below a maximum amount authorized for the at least one PIN code.

Tsiounis et al. disclose checking by said electronic payment center whether the amount of said purchase of the at least one article is below a maximum amount authorized for the at least one PIN code (see paragraph [0052]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Krueger et al. to

Art Unit: 3621

include the step of checking by said electronic payment center whether the amount of said purchase of the at least one article is below a maximum amount authorized for the at least one PIN code. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives payment for the service provided.

Referring to claims 6 and 7, Krueger et al. disclose checking by said electronic payment center that the at least one PIN code is associated with the card number (see claim 1 above). Krueger et al. do not expressly disclose checking by said electronic payment center whether there is a prevalidation of the at least one article by said buyer. Tsiounis et al. disclose checking by said electronic payment center whether there is a prevalidation of the at least one article by said buyer; wherein said prevalidation of the purchase of the at least one article by said buyer is cleared after it has been used (see paragraphs [0062] and [0063]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Krueger et al. to include the step of checking by said electronic payment center whether there is a prevalidation of the at least one article by said buyer. One of ordinary skill in the art would have been motivated to do this because it assist is eliminating duplicate charges to the consumer account.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krueger et al. as applied to claim 9 above.

Krueger et al. disclose the transaction information sent the buyer is at least one article information, PIN code, and credit/debit card number and the transaction information sent by the seller is at least one article information, and PIN code. Krueger et al. does the transaction

information including date and time of purchase. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The receiving transaction information from a buyer and seller by an electronic payment center would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive transaction information including any type of content because such data does not functionally relate to the steps in the method claimed.

9. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krueger et al. in view of Tsiounis et al.

Krueger et al. disclose receiving transaction information from a buyer and a seller by an electronic payment center and performing a validation with the transaction information from the buyer and seller by the electronic payment center (see paragraphs [0029] and [0030]). Krueger et al. do not expressly disclose performing a pre-validation of buyer information with a third party, and providing authentication for a sale by an electronic transaction when the pre-validation and validation provide authorization. Tsiounis et al. disclose performing a pre-validation of buyer information with a third party, and providing authentication for a sale by an electronic transaction when the pre-validation and validation provide authorization (see paragraphs [0052], [0062] and [0063]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Krueger et al. to include the steps of performing a pre-validation of buyer information with a third party, and providing authentication

Art Unit: 3621

for a sale by an electronic transaction when the pre-validation and validation provide authorization. One of ordinary skill in the art would have been motivated to do this because it assist is eliminating duplicate charges to the consumer account.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krueger et al. as applied to claim 9 above, and further in view of Tsiounis et al.

Krueger et al. disclose validating an electronic payment (see claim 9 above). Krueger et al. do not expressly disclose sending an error message to the buyer if a purchase amount is outside an authorized limit of the credit/debit card. Tsiounis et al. disclose sending an error message to the buyer if a purchase amount is outside an authorized limit of the credit/debit card (see paragraph [0052]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Krueger to include the step of sending an error message to the buyer if a purchase amount is outside an authorized limit of the credit/debit card. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives payment for services provided.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

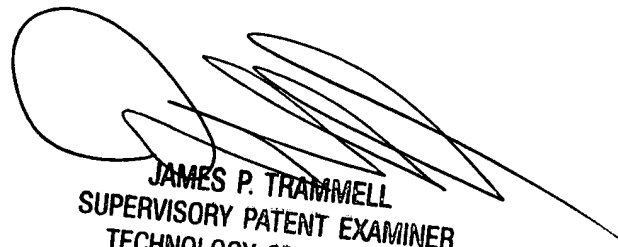
***Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

- Application/Control Number: 09/810,286
Art Unit: 3621

Page 10

March 24, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600